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10/758,262	01/16/2004	Kevin Sullivan	JPC-011 D1	5705

  

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GOODWIN PROCTER LLP 901 NEW YORK AVENUE, N.W. WASHINGTON, DC 20001		

  

EXAMINER	
LIVERSEDGE, JENNIFER L	

  

ART UNIT	PAPER NUMBER
3692	

  

NOTIFICATION DATE	DELIVERY MODE
11/05/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/758,262

Applicant(s)

SULLIVAN, KEVIN

Examiner

Jennifer Liversedge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for continued examination of Application 10/758,262 filed on October 4, 2007.

The amendment contains new claims: 37-52

Claims 1-36 have been canceled.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 4, 2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 51 refers to a recipient of an offer for multiple accounts accepting the offer for multiple accounts and wherein a card payment instrument is established and automatically creating a linked investment account in

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response to that acceptance (third supporting paragraph after preamble). However, the second supporting paragraph refers to creating the card payment instrument without creating the investment account, and the fourth supporting paragraph again refers to creating the card payment instrument without creating the investment account.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 37-38, 40-45 and 47-50 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,070,153 to Simpson (further referred to as Simpson).

Regarding claim 37, Simpson discloses a computerized method for implementation of multiple accounts, wherein a recipient of an offer for multiple accounts accepts the offer for multiple accounts and becomes an approved cardholder (columns 1-6), the method comprising:

Establishing a card payment instrument account through a card issuer for the approved cardholder in response to the acceptance, wherein the card payment

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instrument account includes a reward feature available to the cardholder (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Automatically creating an investment account for the approved cardholder through a financial institution in response to the acceptance (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Linking the card payment instrument account from the card issuer to the investment account from the financial institution (Figure 1; column 2, lines 30-41; column 4, lines 27-37; column 6, lines 19-27);

Implementing the reward feature by tracking expenditures made through the card payment instrument account and calculating a monetary reward amount in relation to the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28); and

Depositing the monetary reward amount generated by the reward feature into the investment account at a predetermined time interval (Figure 3; column 1, lines 45-63).

Regarding claims 44, Simpson discloses a computerized method for establishing and implementing multiple accounts (columns 1-6), the method comprising:

Simultaneously offering multiple accounts including a card payment instrument account through a card issuer and an investment account from a financial institution (column 2, lines 30-38; column 3 line 50-column 4, line 53; column 6, lines 19-26);

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When a recipient of an offer for multiple accounts accepts the offer for multiple accounts, establishing the card payment instrument account in response to the acceptance, wherein the card payment instrument account includes a reward feature available to the recipient (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Automatically creating the investment account in response to the acceptance (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Implementing the reward feature by tracking expenditures made through the card payment instrument account and calculating a monetary reward amount in relation to the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28); and

Depositing the monetary reward amount generated by the reward feature into the investment account at predetermined time intervals (Figure 3; column 1, lines 45-63).

Regarding claims 38 and 45, Simpson discloses allowing independent funding of the investment account by the cardholder (Figures 1 and 3; column 1, lines 54-67; column 2, lines 17-22; column 4, lines 13-19; column 4, line 63-column 5, line 5; column 5, lines 41-59).

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Regarding claims 40 and 47, Simpson discloses wherein the card payment instrument account includes at least one of a credit card account, a stored value card account, a debit card account, and a multi-featured credit on a debit card account (column 1, lines 21-25 and 45-53; column 2, lines 29-49).

Regarding claims 41 and 48, Simpson discloses wherein the investment account includes at least one of a mutual fund account, a stock account, an individual retirement account, a 401(k) plan account, a savings account, a certificate of deposit account, a money market fund, and an employee stock purchase account (column 1, lines 21-25 and 45-53).

Regarding claims 42 and 49, Simpson discloses calculating the monetary reward amount each month as a percentage of net purchases in the card payment instrument account (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

Regarding claims 43 and 50, Simpson discloses transferring the monetary reward amount to the investment account at least once a year (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 39 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson as applied to claims 37 and 44 above, and further in view of US Patent 5,513,102 to Auriemma (further referred to as Auriemma).

Simpson does not disclose issuing a card payment instrument linked to the multiple accounts, the card payment instrument bearing the name of the financial instrument and the name of the card issuer. However, Auriemma discloses the use of co-branded credit cards in which the credit card bearing the name of the card issuer and the name of the organization with which the card issuer is in association with by which a user gains benefits, cash back, incentives, etc. through the partnership (column 1, lines 31-47). It would be obvious to one of ordinary skill in the art at the time of the invention



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to modify the use of a credit card wherein a reward feature is implemented through partnership with another organization as disclosed by Simpson to adapt issuing a credit card that bears partnership organizations on the card. The motivation would be that co-branding a credit card by including the names of participating organizations on the card, rather than just one organization in the partnership, builds customer use in using the card by providing visual queues as to the benefit of the using the card. When a user is preparing to pay for a purchase and opens their wallet and sees, for example, three credit cards, the credit card with a visual reminder that using that card will result in a deposit into one's investment account based on the purchase value will inspire the purchaser to select that card for the purchase over a card which offers no specific and tangible reward. Building loyalty and encouraging use is the motivation behind the use of co-branded credit cards.

Claims 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson.

Simpson discloses a computerized method for establishing and implementing multiple accounts, the method comprising:

Simultaneously offering multiple accounts including a card payment instrument account through a card issuer and an investment account from a financial institution (column 2, lines 30-38; column 3 line 50-column 4, line 53; column 6, lines 19-26), wherein the card payment instrument account includes a reward feature available to the

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recipient (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

When a recipient of an offer for multiple accounts accepts the offer for multiple accounts, establishing the card payment instrument account in response to the acceptance and automatically creating a linked investment account in response to the acceptance (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Implementing the reward feature by tracking expenditures made through the card payment instrument account (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28);

Calculating a monetary reward amount in relation to the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28) and depositing the monetary reward amount generated by the reward feature into the investment account at predetermined time intervals (Figure 3; column 1, lines 45-63).

Simpson does not disclose providing the recipient an option to create the card payment instrument account through the card issuer without creating the investment account from the financial institution and establishing only the card payment instrument and making a subsequent offer to establish a linked investment account. However, it would be obvious to one of ordinary skill in the art at the time of the invention that a card payment instrument could be established with a subsequent offer to establish a linked investment account. An organization, marketing a partnership program in which a card

payment instrument is issued and rebates from purchases are used to fund an investment account, could set up the link to the investment account at any time. Whether the link to the account is activated upon initial acceptance of the card payment instrument, or after receiving a first statement showing the benefits which may potentially be "forfeited" or lost if the offer to accept the investment account is not accepted, or if the card payment instrument owner begins to investigate options related to added value to be obtained from card payment instrument usage at any point in time, activating an investment account at any time would be an obvious marketing and business tool to increase customer loyalty and satisfaction by making offerings available to the customer when they are ready to take advantage of them. Offering the investment account is an added benefit of the association of the credit card issuer and investment fund association. A credit card issuer and investment fund association would be aware of the incentives that they are offering to customers and customers with existing cards would need to be made aware of the new option, whereas potential new card holders would be made aware of the option through an initial offer. It would be obvious to enable to customers to take part in the added incentive of deposits into an investment fund through card usage at card inception or at any future point in time.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 51-52 are rejected on the ground of nonstatutory double patenting over claims 1-3 and 9-11 of U. S. Patent No. 6,941,279 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: establishing a credit card account, monitoring purchases and calculating a rebate based on a percentage of purchases, issuing a statement which includes a calculated rebate and an offer to activate an investment fund account, activating the investment fund account based on acceptance and transferring the rebate to the investment fund.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Response to Arguments***

Applicant's arguments with respect to claims 37-52 have been considered but are moot in view of the new ground(s) of rejection.

A requirement for election/restriction could have been issued in this office action rather than rejection by prior art. Claims 37-50 represent one group, and claims 51-52 represent a second group. In order to advance prosecution in a timely manner given the advanced state of the application, claims 51-52 were rejected using both art and a double patenting rejection rather than issuing a requirement for election/restriction. However, it is noted that the subject matter related to group 1 was claimed in the present application due to an election/restriction for which the material represented by group 2 was selected and the material represented by group 1 was not selected. Accordingly, the subject matter as represented by group 2 in the present application, submitted as new claims, once again takes the application back to the original state which necessitated the election/restriction requirement.

### ***Conclusion***

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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A handwritten signature in black ink, appearing to read 'Kambiz Abdi', is written over a horizontal line.

Kambiz Abdi

Supervisory Patent Examiner

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